

R E M A R K S

The office action of June 9, 2005, has been reviewed and its contents carefully noted. A Request for Continued Examination is being filed with this response. Reconsideration of this case, as amended, is requested. Claims 1 through 67 remain in this case, claims 66-67 being withdrawn from consideration through a restriction requirement.

Preliminary Comments

- a. The numbered paragraphs below correspond to the numbered paragraphs in the Office Action.
- b. Claim Amendments:
 - i. Independent claims 1 and 33 have been amended to change the term "old address" to --first address--. Various claims were amended to change "old" to --first-- to be consistent with the change. The claims as originally filed recited an "old address" which is known to be invalid vs. a "second address" to which the forwarding service sends the communication. It was felt that the pairing "first"/"second" is more consistent than "old"/"second". This was done purely for stylistic reasons, and no new matter or change in claim scope is intended or introduced.
 - ii. Independent claims 1 and 33 are amended to add that the communications are sent "through a service provider", that the forwarding service is separate from the service provider, and that what is sent to the forwarding service comprises at least the first address and the contents of the communications. The "service provider" terminology appears in the specification as filed (for example on page 14, last paragraph). The separation of the service provider from the forwarding service appears in the drawing and specification as filed (see page 8, second paragraph, which also discusses sending the message to the forwarding service). No new matter is introduced.
 - iii. Claims 30 and 63 are amended for consistency with the reworded claims 1 and 33.

iv. Claims 31 and 64 are amended to add --a mail server-- after "the server is" to correct an antecedent basis problem with "the mail server" later in the same claims.

v. Claims 7 and 40 are amended to correct a grammatical error ("are" for --is--)

Affirmation of Election

5. Applicant affirms the election of Group I, claims 1-65.

Rejection(s) under 35 U.S.C. §102

12. Claims 1-6,12-17,20,21,23,24,26,27,29-39,45-50,53,54,56,57,59,60, and 62-65 were rejected under 35 U.S.C. 102(e) as being anticipated by Tsuei U.S. Patent 6,654,779.

Applicant respectfully disagrees with this rejection, as applied to the claims as amended by this response.

The amended independent claims 1 and 33 recite the Applicant's claimed method as:

1. A method of indirectly forwarding a communication from a sender using a service provider to a recipient where a first address for the recipient is known or believed to be temporarily or permanently invalid, by sending the communication comprising at least the first address and communication contents to a forwarding service separate from the sender's service provider and having an address different from that of the recipient, comprising the steps of:

- a) the forwarding service receiving the communication;
- b) the forwarding service looking up at least the first address in a database;
- c) the forwarding service retrieving at least one second address from the database, which second address is associated with the first address;

d) the forwarding service sending the communication to the second address.

33. A method of a sender sending a communication to a recipient via a forwarding service when a first address for the recipient is known or believed to be temporarily or permanently invalid, comprising the step of the sender sending the communication using a service provider to a forwarding service separate from the service provider and having an address different from that of the recipient, the communication comprising at least the first address and communication contents.

Tsuei is what was described in the present specification as a "direct forwarding" system - see page 2, lines 13ff:

This will be referred to herein as "direct forwarding", in that so far as the original sender is concerned, the communication is still sent to the recipient's original address via the ordinary communications server, and the ordinary communications server redirects the communication to a different address to reach the recipient, usually without the knowledge or intervention of the sender.

The Applicant's claimed invention, in contrast to Tsuei's "direct forwarding" system, is an indirect forwarding system.

In Tsuei's system, the sender sends his/her e-mail through his/her ISP to the recipient at its old address. When the e-mail bounces, **the sending ISP sends only the first e-mail address to an E-mail Address Management System (EAMS)** (figure 4, 445). The EAMS looks up the address (450) and **responds to the ISP with a second e-mail address (462)**. **The sender's ISP then sends the new address to the sender (465), and readdresses and resends the undeliverable message to the second address (470)**. In an alternate embodiment, Tsuei's EAMS sends the new address to the Sender, directly, and the Sender then readdresses and resends the message. **Tsuei's EAMS never handles the message ("the communication") itself, and neither the sender nor the sender's ISP ever send the communication to anything but the recipient's address.**

Contrast this with the Applicant's invention, as defined in the amended claims:

The sender, knowing the recipient's first address to be invalid, sends the entire communication (first address and contents) through a service provider to a forwarding service, which has a different address than the recipient and is separate from the service provider. The forwarding service looks up a second address which is related to the first address, and forwards the communication to the second address.

The present claims pertain to **the communication as a whole**, e.g. an e-mail message, and **not simply the recipient's address**. The communication is forwarded by the forwarding service rather than being returned to the sender or sender's ISP for reprocessing. Using the Applicant's invention, the communication is simply forwarded to the recipient at the second address, in one step and without necessarily revealing the updated address to the sender. In addition to increased efficiency, this method can maintain the privacy of the recipient's new address.

The claims have been amended to clarify the invention - specifically, that:

- A sender sends the entire communication (known invalid first address and contents) through a service provider to a forwarding service separate from the service provider
- The forwarding service forwards the communication on to a second, related address - the sender does not resend the message, and need not ever know the second address

Since Tsuei lacks the key elements of Applicant's claims -the sender sends the communication to a forwarding service separate from the service provider which receives the communication, looks up the address, retrieves the new address, and forwards the communication - Applicant believes that the Tsuei reference does not anticipate his invention claimed in claims 1 and 33, and these claims are thus patentable over the cited patent. The dependent claims, being dependent upon and further limiting independent claims 1 and 33, should also be allowable for the same reasons, as well as for the additional recitations they contain. Reconsideration and withdrawal of the rejections are respectfully requested.

Rejection(s) under 35 U.S.C. §103

33. Claims 7-11,18-19,28,40-44,51-52, and 61 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei in view of Fuisz U.S. Patent 6,643,688.

Applicant does not believe that Tsuei teaches or suggests the invention claimed in independent claims 1 and 33, as amended and the claims dependent upon those claims, for the reasons discussed above. The previous argument relative to the section 102 rejection over Tsuei is therefore repeated here by reference.

Fuisz is an e-mail redirector or forwarder, commonly known as an "anonymous remailer". In Fuisz system, the user sets up a user account, and any mail sent to that account is automatically forwarded to one or more other accounts based on filters.

It is not necessary to speculate as to what the combination of Tsuei and Fuisz would produce, as Tsuei already includes a forwarder of the general type represented by Fuisz - see figure 3, "Mail Forwarder" (114). If you replace element (114) in figure 3 with Fuisz, there is effectively no change in Tsuei's system, except that element (114) would have more than one line connecting it to (130) "Internet". The operation of the system would be the same, in that if a message sent by Fuisz's remailer to one of the accounts bounces, the remailer would send an address query to the EAMS, and if the old account is in the database, would receive a new address message from the EAMS, and it would then re-send the message to the new address.

The combination of Tsuei and Fuisz, then, would be the EAMS of Tsuei, used by the remailer of Fuisz, and would not be the forwarding service of the present application.

As neither Tsuei nor Fuisz teaches or suggests Applicant's system of a sender using a service provider to send communications to a forwarding service separate from the service provider, and the communications being forwarded by the forwarding service to a second address related to the first address, as described in the amended claims, the combination of the two cannot teach it or make it obvious. Reconsideration and withdrawal of the rejection is respectfully requested.

37. Claims 22,25,55, and 58, rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei.

In making this rejection, the Examiner stated "Tsuei discloses sending the communication to the second address further comprises the step of including additional information in the communication, and send the confirmation to the sender; however, Tsuei fails to teach additional information is advertising, the confirming communication also comprises additional information at least in the form of advertising."

These claims are dependent upon independent claim 1 (claims 22, 25) or 33 (claims 55, 58), as amended. The arguments as to why Tsuei does not show the invention as claimed in the amended independent claims, as recited above in response to the section 102 rejection, are repeated here by reference. These dependent claims merely narrow the independent claims by defining additional material (advertising) which is added to the forwarded communication sent to the recipient (claims 22, 55) or which is added to a confirming message sent back to the sender (claims 25, 58). With the basic system being novel, adding this material to the forwarded communication does not render the combination obvious.

Reconsideration and withdrawal of the rejection is respectfully requested.

Conclusion

Applicant believes the claims, as amended, are patentable over the prior art, and that this case is now in condition for allowance of all claims therein. Such action is thus respectfully requested. If the Examiner disagrees, or believes for any other reason that direct contact with Applicants' attorney would advance the prosecution of the case to finality, he is invited to telephone the undersigned at the number given below.

Respectfully Submitted:

Dan Schoeffler

By:


Michael F. Brown, Reg. No. 29,619

Attorney for Applicant

BROWN & MICHAELS, P.C.

400 M&T Bank Building - 118 N. Tioga St.

Ithaca, NY 14850

(607) 256-2000 • (607) 256-3628 (fax)

e-mail: docket@bpmlegal.com

Dated: December 7, 2005